



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,311	03/12/2004	Wilfried Blum	P1112US00	5775

76753 7590 10/28/2009

BENOIT & COTE, s.e.n.c.
1001, DE MAISONNEUVE BOULEVARD WEST
SUITE 210
MONTREAL, QC H3A 3C8
CANADA

EXAMINER

FISHER, PAUL R

ART UNIT	PAPER NUMBER
----------	--------------

3689

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@benoit-co.com
marcetmimi@videotron.ca
francc@cable.ca

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/798,311</p>	<p>Applicant(s) BLUM ET AL.</p>	
	<p>Examiner PAUL R. FISHER</p>	<p>Art Unit 3689</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-7,9-20,28,29,31-34 and 36-42.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689

Continuation of 11. does NOT place the application in condition for allowance because: The newly amendments will require further search and consideration and thus will not be entered since the newly recited limitations recite steps not previously considered, such as the act of displaying.

In response to the applicant's argument that, "A "grade" is not equivalent to an "assessment". This is made clear in the following passages taken from the specification," the Examiner respectfully disagrees. The first paragraph recited by the applicant is paragraph [0002]: "Currently there exists no system that allows reducing processing costs by evaluating (i.e., assessing) and grading parts before they leave the dealership". The applicant then states "Note that the term "and" and not "or" is used here to identify the difference between both terms". It appears to the Examiner the applicant has misquoted their own specification. Paragraph [0002] last sentence from the applicant's originally filed application states:

"Currently, there exists no system that allows reducing processing costs by evaluating and grading parts before they leave the dealership"

It is clear from this the word assessing doesn't even appear in this paragraph, therefore it is not possible to say it clear that a grade is different from an assessment.

The applicant then recites paragraph [00020] : "The electronic folder also provides a grade field, which can be filled in at the assessment center (i.e., where the assessment is performed) with a respective grade for the core, following its evaluation (i.e., assessment)." The applicant then states "Again, the grade field is used to enter a grade, not an assessment. Assessment and grade are thus not the same. Again the applicant has added additional language to the specification to try and equate the words. Paragraph [0020] reads:

"The electronic folder also provides a grade field, which can be filled in at the assessment center with a respective grade for the core, following its evaluation."

It is again clear that the word assessment does not appear in the specification. Further this passage does not show that the assessment contains a grade it rather says an evaluation was made and a field containing the grade could be entered into an electronic folder. In this the evaluation is not a tangible item but rather and act.

The applicant then recites paragraph [0037]: "(...), which displays the electronic folder for each assessed part, including the grading, list of missing parts and original images.", this paragraph is the same as the specification however it does not prove that the assessment is different then grading, rather it shows the grading is an assessment, since the rest of the information contained in the folder is has nothing to do with the assessment of the part but rather it includes missing parts and original images. The applicant argues "This identifies the grade, the list of missing parts and original images as a subset of the assessment," the Examiner respectfully disagrees. This shows that the "electronic folder" contains this information not the assessment.

As shown previously the applicant's specification specifically on page 9, paragraph [0034], states "As per step 37, an assessor at the assessment center determines the quality of the core using all of the core information data and additional descriptive information supplied through the electronic folder, if the electronic folder contains sufficient information in order to assess the core (at step 38), then as per step 39, the folder is then returned to the dealer along with the assessment or grading and a list of missing parts. If the assessor cannot accurately determine the quality of the core (at step 38), the assessor can request additional information from the car dealership 21 by returning the electronic core folder with comments or questions. The dealer will add the missing information and return the electronic folder to the assessor. The process can loop through steps 33, 35 and 37 until the assessor is satisfied that the supplied information is sufficient to permit an accurate grading of the quality of the core." From this it is shown that the assessor performs their assessment or grading of the parts this section shows that either the assessment or the grading itself is required to determine the assessment of the condition of the parts, this paragraph no other paragraph in the applicant's specification would lead one of ordinary skill to the conclusion that the grade is included as part of the assessment.

The Examiner asserts that the passages provided by the applicant do not clearly show that the assessment and grading are two separate things and therefore the rejections are maintained.

In response to the applicant's argument that, "Claims 1 and 41 are hereby amended to further recite transformed subject matter," the Examiner respectfully disagrees. No transformation has taken place. The data has not changed form it is still data. Therefore the rejections have been maintained.

In response to the applicant's argument that, "Joao never discloses an assessment comprising a grade for a vehicular part," the Examiner respectfully disagrees. As shown above a grade and an assessment are equivalent terms as shown by the applicant's own specification and Joao disclose page 22, paragraph 293; the user being sent the report or assessment. The Examiner asserts that the reference reads over the claims as currently written and therefore the rejections have been maintained.

In response to the applicant's argument that, "In Joao, it is the CPU, not the assessment center, which generates the report," the Examiner respectfully disagrees. As per the applicant's specification and drawings particularly figure 1, character 27 the assessment center is a CPU or computer. The rejection is maintained.

In response to the applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., not being performed "after a repair (maintenance/procedure) is performed") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no currently limitation that requires that the action can not take place after the maintenance is performed. Therefore the rejection is maintained.

In response to the applicant's argument that, "Joao does not disclose (1) "said electronic folder having been modified at said assessment center to include said grade of said assessment"; and "said output means for sending said electronic folder, once modified to include said grade, to the vehicle dealer, where the grade will be used to determine a disposition of the vehicular part"" the Examiner respectfully disagrees. As shown above and in greater detail in the Final office action dated on August 13, 2009, the reference Joao does disclose these features, therefore the rejection is maintained.

In response to the applicant's argument that Joao does not disclose "grade" or "assessment", the Examiner respectfully disagrees. As shown above in great detail and in the Final rejection the Joao reference does disclose these elements. The rejection is therefore maintained.

All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi where applicable.